

**Appl. No.** : 09/574,819  
**Filed** : May 19, 2000

### **REMARKS**

By this amendment, Applicant has canceled Claims 33-40 as being drawn to a non-elected invention. No claims are added. Thus, Claims 27-32 are pending.

#### **A. Compliance with 35 USC 102**

The Patent Office rejected Claim 27 under 35 USC 102(a) as being anticipated by Storm et al., Nature 368:639 (Apr 1994), which describes a sequence encoding a protein comprising SEQ ID NO:24 but does not describe chondrogenic activity. According to MPEP 715, a Declaration under 37 CFR 1.131 can be used to overcome a 35 USC 102(a) rejection. Attached is a copy of Second Declaration under 37 CFR 1.131 filed in U.S. Pat. Appl. No. 08/836,081, to which this application relates back, to swear behind Storm et al. at a date prior to January 12, 1993. As required by MPEP 715, the Rule 131 Declaration shows as much of the claimed invention as is described in Storm et al. According to the Rule 131 Declaration, the inventors obtained sequences designated in Exhibit A as "17 #27 12.2" and "18 #28 12.2" and designated in Exhibit B as "Sample 23" and "#12, #14" by PCR cloning of a Xenopus genomic library ("17 #27 12.2" and "18 #28 12.2") and PCR cloning of a bovine articular cartilage cDNA library ("Sample 23" and "#12, #14") using degenerate primers based on a consensus sequence found in homologs of bone morphogenetic proteins. These sequences encode a protein comprising SEQ ID NO:24. (Both directions.) The Rule 131 Declaration shows as much of the claimed invention as is described in Storm et al. at a date prior to January 12, 1993, therefore the rejection is overcome.

#### **B. Compliance with 35 USC 103**

The Patent Office rejected the claims under 35 USC 103(a) as being unpatentable over Storm et al., Nature 368:639 (Apr 1994), and Neidhardt PCTEP93/00350, published Aug 19, 1993. Under the statute, a patent may not be obtained if the difference between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made. Neidhardt is admitted not to describe a sequence encoding a protein comprising SEQ ID NO:24, only expression vectors, host cells, and processes for the production of proteins. The Rule 131 Declaration establishes that as much of the claimed invention as is described in Storm et al. was made at a date prior to January 12, 1993.

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At the time the invention was made, Neidhardt's description of only expression vectors, host cells, and processes for the production of proteins could not have rendered the subject matter as a whole obvious because a sequence encoding a protein comprising SEQ ID NO:24 was unknown. The secondary reference does not fill in the gap left by the antedating of the primary reference, thus the rejection cannot prevail.

### **CONCLUSION**

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of all outstanding rejections are respectfully requested. Allowance of the claims at an early date is solicited. If any points remain that can be resolved by telephone, the Examiner is invited to contact the undersigned at the below-given telephone number.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 9/29/03

By: 

Nancy W. Vensko  
Registration No. 36,298  
Attorney of Record  
Customer No. 20,995  
(805) 547-5585

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